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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GRANT II, JEROME	
ART UNIT	**PAPER NUMBER**
2625	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/671,584	MORIKAWA, HIROSHI	
	Examiner	Art Unit	
	Jerome Grant II	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-35* is/are pending in the application.

4a) Of the above claim(s) *18-35* is/are withdrawn from consideration.

5)☒ Claim(s) *10-13* is/are allowed.

6)☒ Claim(s) *6-9 and 14-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT
PRIMARY EXAMINER

Attachment(s)

1) ☑ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 3-06
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

1.

Informality

In claim 6, line 5, third occurrence, change "the" to –an--.

2. Restriction By Original Presentation

Newly submitted claims 18-35 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Of claims 18-35 a second invention (claims 18-23) is defined as a "method for printing data files" . Of claims 18-35 the third invention (claims 24-29) is defined as an image printing device Of claims 18-35 claims 30-35 are directed toward a computer program product stored on a computer readable medium for causing printing files to be printed by a printing device.

The present invention is directed toward a digital image forming apparatus. New claims 18-23 have separate utility in that the method of printing files is not unique to all digital image forming apparatus. There are a plurality of different methods of printing files which could be used with a digital image forming apparatus that is comprised of a printing mechanism. Note that claim 1 does not recite printing files.

The digital image forming apparatus could be a host computer, as broadly as the claims are defined.

Of the third group of claims directed toward the third invention (claims 24-29) these claims are directed toward an image printing device. Note that claim 1 does not recite that it is a printer or that it uses a printing device. Moreover, different printing devices could conceivably be used in combination with a digital image forming apparatus(such as a host computer forming images on a screen. The apparatus does not require the specifics of the printing device to function. Thus, the apparatus and device have separate utility.

The fourth group of claims (claims 30-35) are directed toward a computer program product for printing files on the printing device. The first and the fourth group have separate utility in that the first group does not require a software product to perform the functions of printing a digital forming apparatus. The functions of the program product are distinct from the functions performed by the apparatus and are mutually exclusive. Hence, the two groups have separate utility and purpose.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-35 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-9 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Plakosh.

With respect to claim 6, Plakosh teaches a digital image forming apparatus (20) comprising: A store 10 configured to store a plurality of data in a stored order; a selection device (DMA in imager 20) configured to select an arbitrary desired data order for the plurality of data as claimed (see for example, col. 5, lines 38-52), see also col. 4, lines 10-25; a linking controller (print controller 30) configured to link the plurality of data from the stored into arbitrary desired data order selected by the selection device to form a data group for performing an operation (data read out of memory 10 to printer 20, according to col. 3, lines 27-42); an operation controller configured to receive the data group from the linking controller and to control performance of

the operation using the data in the data group in arbitrary desired data order selected by the selection input device (see col. 6, lines 35-45).

With respect to claim 7, this limitation is inherent by reference of the imager 20 according to col. 1, lines 15-20 and col. 5, lines 3-5.

With respect to claim 8, this limitation is addressed with respect to the print job which consists of printing the first and second side of a document by DMA and memories 50 and 52.

With respect to claim 9, Plakosh teaches wherein the plurality of data in the store includes print job finishing conditions (order or readout of data in the memory, for example, when data is rotated, see col. 5, lines 37-53) and said operation includes print job finishing (possible preparation for book mode printing, according to col. 4, line 17).

With respect to claim 14, Plakosh teaches a method of linking independent data from different locations (copied location or memory location whether virtual or real, see col. 1, lines 30-36 and 41-46) in a storage device to form ordered linked data, comprising:

A store 10 configured to store a plurality of data in a stored order; a selection device (DMA in imager 20) configured to select an arbitrary desired data order for the plurality of data as claimed; a linking controller (print controller 30) configured to link the plurality of data from the stored into arbitrary desired data order selected by the selection device to form a data group for performing an operation (data read out of memory 10 to printer 20, according to col. 3, lines 27-42); an operation controller configured to receive the data group from the linking controller and to control performance of the operation using the data in the data group in arbitrary desired data order selected by the selection input device (see col. 6, lines 35-45).

With respect to claim 15, this limitation is inherent by reference of the imager 20 according to col. 1, lines 15-20 and col. 5, lines 3-5.

With respect to claim 16, this limitation is addressed with respect to the print job which consists of printing the first and second side of a document by DMA and memories 50 and 52.

With respect to claim 17, Plakosh teaches wherein the plurality of data in the store includes print job finishing conditions (order or readout of data in the memory, for example, when data is rotated, see col. 5, lines 37-53) and said operation includes print job finishing (possible preparation for book mode printing, according to col. 4, line 17).

4.

Claims Allowed

Claims 10-13 are allowed since there is no computer program described to perform the claimed functions.

5.

Examiner's Remarks

Applicant's sole argument appears to be the alleged lack of support for the second limitation of claims 6 and 14.

The examiner relied on the arbitrary desired data order as the order read by the DMA from memory 10 to imager 20.

Arbitrary: ... depending on individual discretion and not fixed by law; based on or determined by individual preference or convenience rather than by necessity or intrinsic nature of something; existing or coming about seemingly at random or by chance or as a capricious and unreasonable act of will...

In the mind of the examiner, and as applicant concurs, "arbitrary" is interpreted in the broadest reasonable interpretation in view of the specification. The examiner contends that based on the definition as defined by Webster's Collegiate Dictionary, the term "arbitrary" is commensurate with the application of the use of the word as it appears in the function of the claims and supported in the specification. Any order of reading by the DMA of data from the memory 10 to the imager 20 is an arbitrary read out.

Regarding the additional phrase, " without regard to the stored order" this simply refers to the fact that data is selected in an order without regard to how it is stored. This is certainly what is discussed by Plakosh. The examiner contends that Plakosh teaches reading the order of the data in a forward and reverse direction regardless as to how the data is stored. See col. 5, lines 38-52, for example.

Hence, Plakosh teaches a selection between a foreward or reverse readout to affect recording of images see col. 5, lines 38-52. Therefore, the "arbitrary selection" is a forward or reverse readout regardless of how the data is stored in memory 10. Hence the claim limitation is clearly anticipated.

6.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II

JEROME GRANT
PRIMARY EXAMINER